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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,046

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Yoshihiro Sekiya

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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

FORD, JOHN K

ART UNIT

PAPER NUMBER

3744

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,046	Applicant(s) SEKIYA ET AL.	
	Examiner John K. Ford	Art Unit 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 6-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/1/09, 4/9/08, 12/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of May 1, 2009 has been studied carefully. Applicant has elected Group I, claims 1-6, with traverse. Within Group I, applicant has also elected the overall species of Figure 2 (all of elected claims 1-6 being deemed, by applicant, readable on that overall species). Within Group I, applicant has also elected the first species of tension applying means illustrated in Figures 4-5 (and has identified claims 1 and 3-5 as being readable on that species). Finally, in order to be responsive to the election requirement, applicant has elected a seal species of Figure 27 (claims 28-34) which election is deemed moot because that species is apparently outside of the elected subject matter of Group I as evidenced by applicant's enumeration of claims readable on that species.

Applicant's traverse of the restriction requirement is noted. Apparently, applicant takes issue with the analysis of the claims and the restriction requirement set forth in the supplemental EPO search report which the undersigned has adopted as his own. After quoting PCT Rule 13.2 and the paraphrase of PCT Rule 13.2 from the MPEP, applicant engages in no analysis whatsoever of what, if anything, the EPO did wrong. Labeling the EPO analysis as "unfounded" does not pass muster as pointing out what are perceived by applicant to be error(s) in the EPO analysis. Given the numerous "X" references applied against at least claim 1 (which applicant has not traversed in his response), it is beyond the examiner's comprehension how applicant can assert (again, without any substantive analysis of any limitation in any of the currently pending claims)

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that all of the common special technical features (of claim 1, for example) are patentable, if that is indeed what applicant is attempting to do.

The EPO is, in this examiner's opinion, the "gold standard" when they choose to apply the Rules of the PCT, given their familiarity with them and the similarity of those rules to the restriction rules in European National Stage applications. Finally, no fewer than eight different separately filed Japanese priority applications (largely independent from one another) were bundled together to make up this one, larger than average, application filing. Did applicant successfully traverse the restriction requirement in the EPO? If not, why is applicant attempting to do here?

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The restriction/election requirements are deemed proper and made final.

An action on the merits as to claims 1 and 3-5 follows.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant is claiming the recited gap improperly. The 1 mm gap applicant is attempting to claim is correctly described in the paragraph bridging pages 39-40 of the specification and is clearly shown in Figure 4 (i.e. the gap between the upper portion of projection 30 and the lower portion of element 25). Claim 4 incorrectly claims (as 1mm) the distance between the point of contact projection and the linear non-contact projection – a different gap entirely.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by JP 2004-098780.

Slide door 6 moves along a guide groove 7 formed between guide walls 10a and 10b. The tension applying means is composed of elastic members 12 as well as stoppers 13 and 14. Regarding claim 3, the point of contact projection is the portion of elastic element 12 (hereinafter, the “apex”) that is in contact with wall 10a in Figure 7. The linear non-contact projection is made up of element 14 in Figure 7 and the wall (no reference numeral) immediately below seal 19 in Figure 7. The tension bridge is the portion of elastic element 12 that is not in contact with wall 10a in Figure 7 (hereinafter, the “non-apex”).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2004-098780.

While JP ‘780 does not include the dimension of the gap between the point of contact projection and the linear non-contact projection it is submitted that one of ordinary skill in the art would recognize this variable to be a result effective variable that would depend, for example, on the materials that were used to construct the point of contact projection and the linear non-contact projection. As disclosed by applicant, for whatever plastic applicant uses, apparently 1mm is a good value to compensate for wear over time. If the same elements were made of metal, such as steel, one of

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ordinary skill in the art would choose smaller values since steel, because of its toughness, wears away much less rapidly than plastic. The particular value of the gap is therefore a design selection depending on factors not being claimed (such as materials of construction) and up for the designer to choose as it is a result effective variable and the subject of routine optimization. See In re Aller, 105 USPQ 233 (CCPA 1955).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/John K. Ford/
Primary Examiner, Art Unit 3744